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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,661	08/11/2003	Shoji Imaizumi	44085-169	3540
7590	10/21/2004			
McDermott, Will & Emery 600 13th Street, N.W. Washington, DC 20005-3096				
			EXAMINER CHEN, WENPENG	
			ART UNIT 2624	PAPER NUMBER

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/637,661	Applicant(s) IMAIZUMI ET AL.	
	Examiner Wenpeng Chen	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-14 and 26-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/346,276.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/11/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

Specification

1. The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words. The abstract should not exceed 25 lines of text.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

(f) he did not himself invent the subject matter sought to be patented.

4. Claims 11-14 and 26-31 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Imaizumi et al. (US patent 6,21,512 cited in IDS.)

Imaizumi et al. (US patent 6,21,512) was filed in US on 6/10/1999. The invention entity lists three names (Imaizumi, Hirota, Sugiura.)

The present application was filed in US on 7/1/1999. The invention entity lists four names (Imaizumi, Hirota, Sugiura, Tsuboi.) Although the present application claims foreign priority on three Japanese applications, all filed in Japan on 7/3/1998,) the priority is ignored before English translations of the three Japanese applications are provided to USPTO to confirm the priority claims. As a consequence, the invention date of the present application is set as the US filing date 7/1/1999.

Imaizumi et al (US patent 6,21,512) with a different invention entity is qualified as a 102(e) reference.

The Examiner has compared the present application and Imaizumi et al. (US patent 6,21,512) and found the followings between these two documents are exactly the same:

- (1) all drawings,
- (2) the whole section of "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS."

Because Claims 11-14 and 26-31 are supported by its own drawings and section of "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS," they are clearly anticipated by Imaizumi et al. (US patent 6,21,512.)

5. Claims 11-14 and 26-31 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Imaizumi et al. (US patent 6,441,915 cited in IDS.)

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Imaizumi et al. (US patent 6,441,915) was filed in US on 6/10/1999. The invention entity lists three names (Imaizumi, Hirota, Sugiura.)

The present application was filed in US on 7/1/1999. The invention entity lists four names (Imaizumi, Hirota, Sugiura, Tsuboi.) Although the present application claims foreign priority on three Japanese applications, all filed in Japan on 7/3/1998,) the priority is ignored before English translations of the three Japanese applications are provided to USPTO to confirm the priority claims. As a consequence, the invention date of the present application is set as the US filing date 7/1/1999.

Imaizumi et al (US patent 6,441,915) with a different invention entity is qualified as a 102(e) reference.

The Examiner has compared the present application and Imaizumi et al. (US patent 6,441,915) and found the followings between these two documents are exactly the same:

(1) all drawings,

(2) the whole section of "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS."

Because Claims 11-14 and 26-31 are supported by its own drawings and section of "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS," they are clearly anticipated by Imaizumi et al. (US patent 6,441,915.)

6. Claims 11-14 and 26-31 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

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As explained above, the invention entity (Imaizumi, Hirota, Sugiura) invents both Imaizumi et al. (US patent 6,21,512) and Imaizumi et al. (US patent 6,441,915) that have the same drawings and the same section of "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS as those disclosed in the present application. As a consequence, Imaizumi, Hirota, and Sugiura as a team also teach every aspect disclosed in the present application. They made the present invention.

The present application lists four names (Imaizumi, Hirota, Sugiura, Tsuboi) as inventors. Because Imaizumi, Hirota, and Sugiura invented the same invention on 6/11/1998, at least Tsuboi did not have any contribution and is not an inventor.

7. Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Kanai et al. (Japan patent 10148779 cited in IDS.)

The corresponding US patent for Japan patent 10148779 is Kanai et al. (US patent 6,323,955.)

Kanai teaches an image forming apparatus comprising:

- a printer which forms an image according to image data; (Fig. 1)
- a sensor which detects image distortion in the image formed by said printer; (sections 0020-0024)
- a corrector which corrects the image data according to the image distortion detected by the sensor, wherein the corrector can correct the image distortion within a predetermined range; (sections 0020 and 0034-35; The controller/signal processor performs this correction. The timing shift and the percentage area are selected according a table for correction. A table has limited

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numbers of entries and thus defined maximum and minimum value for input and output values.

The table thus defines the ranges of inputs and outputs. When a table is used, the image is corrected within a predetermined range set inherently in the table.)

-- a controller which continues a print operation even though the image distortion detected by said sensor exceeds the predetermined range. (Because Kanai does not teach stopping printing under any condition. Kanai also teaches this feature.)

8. Claims 11-14, 26-27, and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukushima (US patent 6,115,561.)

Fukushima teaches an image forming apparatus comprising:

-- a printer which forms an image according to image data in the unit of each pixel;
(column 10, lines 14-35)

-- a sensor which detects a quantity of image distortion in the image formed by said printer; (column 10, line 10 to column 11, line 20; The ΔD is the distortion.)

-- a corrector which corrects the image by providing print data according to the quantity of image distortion detected by said sensor, wherein said corrector corrects the image distortion in a predetermined range; (column 11, lines 11-30; The correction is limited to a range for negative ΔD .)

-- a controller which sets the quantity of image distortion to a maximum in a predetermined range when the quantity of image distortion detected by said sensor exceeds the predetermined range and makes said corrector correct the image according to the corrected

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quantity of image distortion; wherein the controller continues a print operation even though the image distortion detected by said sensor exceeds the predetermined range; (column 11, lines 11-30; The correction is set at zero for positive ΔD .)

-- wherein said printer performs printing with a plurality of print colors and said sensor detects the quantity of image distortion of other colors than a reference color in the print colors relative to the image of the reference color; (column 10, line 14 to column 11, line 20)

-- wherein said printer comprises a plurality of image-forming units in correspondence to the plurality of print colors, and said image-forming units are arranged serially; (Part B of Fig. 1; components 120, 130, 140, and 150)

-- wherein said corrector corrects the image distortion in a main scan direction and in a subscan direction; (As shown in Fig. 1, the image are printed in a main scan direction and in a subscan direction. Therefore, the correction is also performed in both directions.)

-- wherein the controller sets the image distortion to a maximum value in the predetermined range. (column 11, lines 11-30; The correction is set at zero for positive ΔD .)

Examiner's Comment

9. The prior art excluding Imaizumi et al. (US patent 6,21,512) and Imaizumi et al. (US patent 6,441,915) does not teach Claim 28.

Conclusion

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wenpeng Chen whose telephone number is 703 306-2796. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on 703 308-7452. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications. TC 2600's customer service number is 703-306-0377.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

Wenpeng Chen
Primary Examiner
Art Unit 2624

October 18, 2004

